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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,986

10/20/2005

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

2629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,986	<b>Applicant(s)</b> SUGA, MASANAO	
	<b>Examiner</b> MY-CHAU T. TRAN	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Application and Claims Status***

1. Applicant's preliminary amendments filed 12/29/2006 are acknowledged and entered.
2. Claims 1-6 were pending. Applicant has amended claims 3-6. No claims were added and/or cancelled. Additionally, applicant has also amended the Abstract, Drawings, and filed a Substitute Specification. Therefore, claims 1-6 are currently pending and are under consideration in this Office Action.

### ***Priority***

3. This instant application is a 371 of PCT/JP04/05820 filed on 04/22/2004, and as a result this instant application has the effective filing date of 04/22/2004.
4. Receipt is acknowledged of papers, i.e. Japanese Patent Application No. 2003-118297, filed April 23, 2003, submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

5. The information disclosure statements (IDSs) filed on 10/20/2005 and 01/25/2008 have been reviewed, and the references that have been considered are initialed as recorded in PTO-1449 form(s).

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6. The information disclosure statement filed 01/25/2008 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the references submitted were not identified on the PTO-1449 form, i.e. the form is blank. Thus, it unclear whether the references are to be considered and/or its identity. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Drawings***

7. The drawings were received on 12/29/2006. These drawings are acceptable.

### ***Specification***

8. The abstract of the disclosure is objected to because the amended abstract contains reference characters in parentheses that refer to the figures of the instant specification, however, not all the reference characters are found in all figures of the instant specification, which result in confusion. And, some reference characters are use to denotes different claimed structural features and/or different reference characters are use to denotes the same claimed structural feature. For example, the reference character of 8 is refers to as a processing unit in figure 1, but the processing unit of figure 11 is designated with a reference character of 9, and as a result, it is

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unclear whether they are the same structure or different structure. Consequently, it is suggested that these reference characters in parentheses should be deleted. Correction is required. See MPEP § 608.01(b).

9. The substitute specification filed 12/29/2006 has been entered.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 is vague and indefinite for it is unclear as to the metes and bounds of the claimed device. Claim 1 first recites the term “*numeral value display apparatus*” and in the body of the claim also recites the term “*numeral value display system*”, and as a result it is unclear whether both of these devices are synonymous device, or they are two distinct devices, i.e. each having distinct structural feature(s), or the “*numeral value display system*” is one of the structural features that define the instant claimed “*numeral value display apparatus*”. Moreover, the dependent claims (claims 2-6) recite the term “*numeral value display system*”. Therefore, claim 1 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

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**b.** The term “*controls to subdivide*” of claim 1 is vague and indefinite because it is unclear as to whether the action being performed by the recited ‘*display processing unit*’ is a physical action (transforming an article or material) or abstract ideas (an algorithm and/or data structures of a software code). Thus, claim 1 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

**c.** The term “*displayed can be grasped*” of claim 1 is vague and indefinite because it is unclear to whether the action being performed by the recited ‘*display processing unit*’ is a physical action (transforming an article or material) or abstract ideas (an algorithm and/or data structures of a software code). Consequently, claim 1 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

**d.** The term ‘*member*’ of claims 2-6 is vague and indefinite because it is unclear as to whether the term ‘*member*’ is a structural feature such as a register, transistor, or a jump-condition circuit; or a functional feature of the recited ‘*display processing unit*’. The instant specification of define the term ‘*member*’ as a process step (see specification pgs. 7-8; fig. 2). As a result, claims 2-6 are rejected under 35 U.S.C. 112, second paragraph.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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13. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (US Patent 4,476,541).

For *claim 1*, Watanabe et al. disclose an electronic calculator (see e.g. Abstract; col. 1, lines 59-68; col. 2, lines 47-55). As illustrated by figure 1, the calculator (refers to instant claimed numeral value display apparatus/numeral value display system) comprises a control section (ref. #2) (refers to instant claimed display processing unit) with a ROM (ref. #2A) (refers to instant claimed storage member), key input section (ref. #1) (refers to instant claimed operation key), and a display section (ref. #8) (refers to instant claimed numeral value display device) (see e.g. col. 4, lines 6-58).

The functional limitations of the instant claimed display processing unit (i.e. ‘*executes such an operation that the numeral value stored in the storage member is read out to display the read numeral value*’ and ‘*controls to subdivide the numeral value into a preset digit number in order that such a fact that which numeral portion of the numeral value to be displayed is displayed can be grasped, and to display a portion of the subdivided numeral values*’) does not impart any structural distinction between the display processing unit of Watanabe et al. and the instant claimed display processing unit, and as a result the device of Watanabe et al. would still anticipate the instant claimed device since the device of Watanabe et al. meet all the structural limitations of the instant claimed device, i.e. a display processing unit, a storage member, an operation key, and a numeral value display device of instant claim 1. See MPEP § 2114, which states as follows:

*APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART*  
>While features of an apparatus may be recited either structurally or functionally, claims< directed to  
>an< apparatus must be distinguished from the prior art in terms of structure rather than function.  
>In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see

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also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

And also that:

*MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART*

**A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).**

Moreover, Watanabe et al. also disclose that the control section (ref. #2) (refers to instant claimed display processing unit) can ‘*executes such an operation that the numeral value stored in the storage member is read out to display the read numeral value*’ as claimed in instant claim 1 (see e.g. col. 4, lines 19-40).

Therefore, the device of Watanabe et al. does anticipate the instant claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is (571)272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Richard A. Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MY-CHAU T. TRAN/  
Primary Examiner, Art Unit 2629

February 13, 2009